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Part II

Department of Commerce

Patent and Trademark Office

37 CFR Parts 1, 5, 10, 41, and 104
Changes To Support Implementation of
the United States Patent and Trademark
Office 21st Century Strategic Plan; Final
Rule

blanket exception for reissue applications. Regardless of when the reissue application was filed, applicant is not required to file an accompanying terminal disclaimer with a petition to revive under § 1.137.

Section 1.165: Section 1.165(b) is amended to remove the requirement for a black and white copy of a color drawing or photograph. This requirement has already been waived. See *Interim Waiver of Parts of 37 CFR 1.84 and 1.165, and Delay in the Enforcement of the Change in 37 CFR 1.84(e) to No Longer Permit Mounting of Photographs*, 1246 Off. Gaz. Pat. Office 103 (May 22, 2001).

Section 1.173: Section 1.173(b) is amended to clarify that paragraphs (b)(1), (b)(2) and (b)(3) are directly related to, and should be read with, paragraph (b).

Section 1.175: Section 1.175 is amended by adding a new paragraph (e), which requires a new oath or declaration which identifies an error not corrected in an earlier reissue application be filed in any continuing reissue application that does not replace its parent reissue application.

Section 1.175 was previously interpreted to require any continuing reissue application whose parent application has not been abandoned to include an oath or declaration identifying at least one error being corrected, which error is different from the error(s) being corrected in the parent reissue (or an earlier reissue). Such interpretation is now clarified by the addition of paragraph (e) to § 1.175. Ordinarily, a single reissue application is filed to replace a single original patent and corrects all of the errors recognized by the applicant at the time of filing of the (single) reissue. If, during the prosecution of the reissue application, applicant (patentee) recognizes additional errors needing corrections, such corrections could, and should, be made in the same application. If, however, after the close of prosecution and up until the time that the first reissue issues, applicant recognizes a further error which needs correction and files a continuing reissue application, § 1.175(e) now explicitly requires applicant to include an oath or declaration which identifies an error which was not corrected in the parent reissue application or in an earlier reissue application, e.g., a grandparent reissue application.

Section 1.178: Section 1.178 is amended to eliminate the requirement for physical surrender of the original letters patent (i.e., the "ribbon copy" of the original patent) in a reissue application, and to make surrender of

the original patent automatic upon the grant of the reissue patent. The reissue statute provides in part that:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent.

See 35 U.S.C. 251, § 1 (emphasis added).

While 35 U.S.C. 251, § 1, requires a "surrender" of the original patent, it neither requires a physical surrender of the actual letters patent, nor a statement that the patent owner surrenders the patent. Physical surrender by submission of the letters patent (i.e., the copy of the original patent grant) was previously required by rule via § 1.178; however, such submission was only symbolic because the patent right exists independently of physical possession of the letters patent.

It is the right to the original patent that must be surrendered upon grant of the reissue patent, rather than any physical document. Thus, where the letters patent is not submitted during the prosecution of the reissue application because it is stated in the reissue that the letters patent copy of the patent is lost or inaccessible, there is no evidence that any stigma is attached to the reissue patent by the public. Further, there was no case law treating such a reissue patent adversely due to the failure to submit the letters patent. In fact, there is no legal reason to retain the requirement for physical surrender of the letters patent. Conversely, it is beneficial to eliminate the requirement for physical surrender of the letters patent.

It is beneficial to both the Office and the public to establish that the surrender of the original patent is automatic upon the grant of the reissue patent to thereby eliminate the requirement for a physical submission of the letters patent or the filing of a paper offering to physically surrender the letters patent (§ 1.178(a)).

Previously, the requirement for submission of the patent document compelled the patent owner (seeking reissue) to try to obtain the letters patent copy of the patent. If the document was lost or misplaced, the patent owner had to search for it. If it was in the hands of a former employee, the patentee had to make an effort to secure it from that employee (who might not be on friendly

terms with the patentee). If the letters patent was obtained, it then had to be physically submitted without losing or destroying it. If the letters patent could not be obtained, the patent owner had to make a statement of loss (Form PTO/SB/55) or explain that it could not be obtained from the party having physical possession of it. The revision of § 1.178 eliminates these burdens, and the requirement for use of form PTO/SB/55 or its equivalent.

The requirement for submission of the letters patent copy of the patent previously provided an unnecessary drain on Office processing and storage resources in dealing with the submitted letters patent document. Further, in the event the reissue was not granted, the Office had to return the letters patent to the applicant where such was requested. The revision does away with the burden on the Office of processing, storing, and returning letters patent.

The previous requirement for submission of the original patent (the letters patent), or a statement as to its loss, resulted in a "built in" delay in the prosecution while the Office awaited submission of the letters patent or the statement of loss, which was often submitted only after an indication of allowance of claims. The revision reduces reissue application pendency because the Office no longer needs to delay prosecution while waiting for the letters patent or the statement of loss. Thus, the complete elimination of the requirement for an affirmative act (of surrender) by the patent owner puts reissue in step with other post patent proceedings for changes of patents which have no requirement for a statement of surrender (e.g., reexamination certificate, certificate of correction).

Amended § 1.178 applies retroactively to all pending applications. For those applications with an outstanding requirement for the physical surrender of the original letters patent, applicant must timely reply that the requirement is moot in view of the implementation of the instant amended rule. Such a reply will be considered a complete reply to any requirement directed toward the surrender of the original letters patent. It is to be noted that the Office will not conduct a search to withdraw Office actions where the only outstanding requirement is compliance with the physical surrender of the original letters patent.

Example 1: An Office action issues prior to the effective date of the amendment to § 1.178 with only a requirement for a return of the original letters patent to the Office. Applicant fails to timely reply to the Office action,

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application is made either by physically incorporating the changes into the specification when the application is filed, or by a separate amendment paper. If amendment is made by incorporation, markings pursuant to paragraph (d) of this section must be used. If amendment is made by an amendment paper, the paper must direct that specified changes be made, as follows:

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38. Section 1.175 is amended by adding a new paragraph (e) to read as follows:

§ 1.175 Reissue oath or declaration.

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(e) The filing of any continuing reissue application which does not replace its parent reissue application must include an oath or declaration which, pursuant to paragraph (a)(1) of this section, identifies at least one error in the original patent which has not been corrected by the parent reissue application or an earlier reissue application. All other requirements relating to oaths or declarations must also be met.

39. Section 1.178 is amended by revising paragraph (a) to read as follows:

§ 1.178 Original patent; continuing duty of applicant.

(a) The application for reissue of a patent shall constitute an offer to surrender that patent, and the surrender shall take effect upon reissue of the patent. Until a reissue application is granted, the original patent shall remain in effect.

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§ 1.179 [Removed and Replaced]

40. Section 1.179 is removed and reserved.

41. Section 1.182 is revised to read as follows:

§ 1.182 Questions not specifically provided for.

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

42. Section 1.183 is revised to read as follows:

§ 1.183 Suspension of rules.

In an extraordinary situation, when justice requires, any requirement of the

regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

43. Section 1.215 is amended by revising paragraphs (a) and (c) to read as follows:

§ 1.215 Patent application publication.

(a) The publication of an application under 35 U.S.C. 122(b) shall include a patent application publication. The date of publication shall be indicated on the patent application publication. The patent application publication will be based upon the specification and drawings deposited on the filing date of the application, as well as the executed oath or declaration submitted to complete the application. The patent application publication may also be based upon amendments to the specification (other than the abstract or the claims) that are reflected in a substitute specification under § 1.125(b), amendments to the abstract under § 1.121(b), amendments to the claims that are reflected in a complete claim listing under § 1.121(c), and amendments to the drawings under § 1.121(d), provided that such substitute specification or amendment is submitted in sufficient time to be entered into the Office file wrapper of the application before technical preparations for publication of the application have begun. Technical preparations for publication of an application generally begin four months prior to the projected date of publication. The patent application publication of an application that has entered the national stage under 35 U.S.C. 371 may also include amendments made during the international stage. See paragraph (c) of this section for publication of an application based upon a copy of the application submitted via the Office electronic filing system.

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(c) At applicant's option, the patent application publication will be based upon the copy of the application (specification, drawings, and oath or declaration) as amended, provided that applicant supplies such a copy in compliance with the Office electronic filing system requirements within one month of the mailing date of the first Office communication that includes a confirmation number for the application, or fourteen months of the earliest filing date for which a benefit is

sought under title 35, United States Code, whichever is later.

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44. Section 1.291 is revised to read as follows:

§ 1.291 Protest by the public against pending applications.

(a) A protest may be filed by a member of the public against a pending application, and it will be matched with the application file if it adequately identifies the patent application. A protest submitted within the time frame of paragraph (b) of this section, which is not matched, or not matched in a timely manner to permit review by the examiner during prosecution, due to inadequate identification, may not be entered and may be returned to the protestor where practical, or, if return is not practical, discarded.

(b) The protest will be entered into the record of the application if, in addition to complying with paragraph (c) of this section, the protest has been served upon the applicant in accordance with § 1.248, or filed with the Office in duplicate in the event service is not possible; and, except for paragraph (b)(1) of this section, the protest was filed prior to the date the application was published under § 1.211, or a notice of allowance under § 1.311 was mailed, whichever occurs first.

(1) If a protest is accompanied by the written consent of the applicant, the protest will be considered if the protest is matched with the application in time to permit review during prosecution.

(2) A statement must accompany a protest that it is the first protest submitted in the application by the real party in interest who is submitting the protest; or the protest must comply with paragraph (c)(5) of this section. This section does not apply to the first protest filed in an application.

(c) In addition to compliance with paragraphs (a) and (b) of this section, a protest must include:

(1) A listing of the patents, publications, or other information relied upon;

(2) A concise explanation of the relevance of each item listed pursuant to paragraph (c)(1) of this section;

(3) A copy of each listed patent, publication, or other item of information in written form, or at least the pertinent portions thereof;

(4) An English language translation of all the necessary and pertinent parts of any non-English language patent, publication, or other item of information relied upon; and

(5) If it is a second or subsequent protest by the same real party in interest, an explanation as to why the